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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,826	03/26/2001	Sheila D. Fox-Lovell	69061.2	7866

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EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 02/13/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,826

Applicant(s)

FOX-LOVELL, SHEILA D.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/14/03 & 12/9/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-15 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. In view of the Appeal Brief filed on November 14, 2003, PROSECUTION IS HEREBY REOPENED. New grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin (4,907,904) in view of Jackson ('090).

Regarding claim 15, Baldwin discloses a personal information system for maintaining information comprising at least one first substrate (20) locatable at a first

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location (the first location being the pocket (18) releasably retaining the board (20)); a plurality of registration labels (25) detachably adhered to the first substrate (see col. 2, lines 25-34 and 59-66), each of the labels are either blank or have first indicia (27) preprinted thereon (see col. 1, lines 36-45), each of the labels further having at least one field within which the information is to be entered in writing by the customer (see col. 1, lines 46-52); when the first substrate is removed from the pocket, the substrate is located sufficiently accessible to the customer to permit the customer to view the labels detachably adhered to the first substrate and to enter the information in the field of one of the labels while the one of the labels remains detachably adhered to the first substrate; and a registration log (as seen in figure 1) having at least one second substrate (30), the second substrate having a plurality of label-retaining spaces (30') and a series of second indicia (31), each one of the spaces including an area to which the respective corresponding one of the labels may be adhered after the information has been entered in writing in the field by the customer and the corresponding one of the labels has been detached from the first substrate so that the labels adhered to the second substrate provide an original record of the writing (see col. 2, lines 56-66), the second substrate being locatable at a second location (the second location being retained by the binding mechanism of the notebook via the apertures in the pages 30) at a time when the first substrate is located at the first location (as seen in figure 1), the second location being a location at which the entered information on any of the labels adhered to the second substrate is out of view of the customer when the first substrate is removed from the pocket and maintained in a location remote from the notebook.

Baldwin discloses the claimed invention except for the specific arrangement and/or content of indicia (the first indicia identifying the position of each of the labels in an uninterrupted sequence and the second indicia corresponding to the first indicia to associate each one of the spaces with a respective corresponding one of the labels according to the sequence) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia for the first and second indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of personal information system does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Furthermore, Jackson discloses a log book (10) comprising a first substrate (12) locatable at a first location; a plurality of labels (i.e., 14A) detachably adhered to the first substrate, each of the labels having one of a series of first indicia (14AA) identifying the position of each of the labels in an uninterrupted sequence. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify

Baldwin's invention to include indicia identifying the position of each of the labels in an uninterrupted sequence, as taught by Jackson, to properly align the labels with the label retaining spaces in chronological order.

Regarding claim 2, Baldwin, as modified by Jackson, discloses the registration log including more than one second substrate (see col. 2, lines 18-24 – “pages 30”). Regarding each second substrate including third indicia to identify a sequential order of the second substrates in the registration log, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia for the second substrates since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of substrate does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claim 3, Baldwin, as modified by Jackson, discloses a designated area for a user to enter information (see col. 1, lines 36-45 – blank labels would enable the user to enter any desired information; to include a date on which services were provided to the customer).

Regarding claim 4, Baldwin, as modified by Jackson, discloses the label-retaining spaces having indicia (31)(see col. 2, lines 22-24). Presuming, *arguendo*, that applicant does not consider the indicia of Baldwin to be text, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include instructions on how to attach the labels in the label-retaining spaces of the second substrates, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of second substrate does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claim 5, see the above rejections to claim 15.

Regarding claim 6, see the above rejections to claim 15.

Regarding claim 7, Baldwin, as modified by Jackson, discloses the first substrate including a first surface and a mutually opposed second surface and the plurality of labels being adhered only to the first surface (as seen in figure 1).

Regarding claim 8, Baldwin, as modified by Jackson, discloses the second substrate including a first surface and a mutually opposed second surface and the

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plurality of label-retaining spaces being disposed on both the first and second surfaces (see col. 2, lines 18-22).

Regarding claim 9, Baldwin, as modified by Jackson, discloses the first indicia comprising a numeral and a letter of the alphabet (see Jackson, figure 1).

Regarding claim 10, see the above rejections to claim 15 regarding indicia.

Regarding claim 11, Baldwin, as modified by Jackson, discloses the registration log being a spiral bound book (as seen in figure 1 of Jackson).

Response to Arguments

4. Applicant's arguments with respect to claims 2-11 and 15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose recordation systems.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (7:00 AM - 4:30 PM).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone


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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 9, 2004


MONICA S. CARTER
PRIMARY EXAMINER


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